

REMARKS

Claims 65-77 are pending in this application. Claims 1-64 were previously cancelled. Claims 66 and 67 have been amended. Claims 78-81 are new. Upon entry of these amendments, claims 65-81 are pending and under active consideration. Applicant respectfully requests entry of the amendments and remarks made herein into the file history of the present application.

Claim 66 has been amended to delete the term "homolog". Claim 67 has been amended to include the phrase "wherein said antibody specifically binds to a portion of the sequence set forth in SEQ ID NO:4." Support for amended claim 67 may be found at page 54, lines 20-28 of the specification as filed. Claims 70-77 have been amended to correct dependency. Support for new claims 78-81 may be found in Examples 3, 6, and 16, at pages 30, 39, and 76, respectively, of the specification as filed. Accordingly, Applicant respectfully submits that no new matter has been added.

Applicant has amended the "Brief Description of the Drawing" to add sequence identifiers for the five sequences represented in Figure 1. Applicant has amended the paragraph beginning at page 23, line 13 of the specification as filed to add sequence identifiers for the primers designated H61-5 and H61-3, SEQ ID NO:18 and SEQ ID NO:19, respectively. An amended sequence listing under 37 C.F.R. 1.825 has also been provided.

a. 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claim 67 as vague for failure to specify what the fusion protein comprises or what the antibody binds. Claim 67 has been amended to state that the claimed antibody must specifically bind to a portion of a fusion protein that comprises SEQ ID NO:4. That is, with reference to the Examiner's example, an antibody that binds only to betagalactosidase of a betagalactosidase-Cyr61 fusion protein would not be included within the scope of claim 67. However, an antibody that binds to a portion of Cyr61 of a betagalactosidase-Cyr61 fusion protein would be included within the scope of claim 67. Accordingly, Applicant respectfully requests the Examiner withdraw the rejections under 35 U.S.C. § 112, second paragraph.

b. 35 U.S.C. § 102(b)

The Examiner has rejected claims 65-77 under 35 U.S.C. § 102(b) for lack of novelty in view of O'Brien and Yang, and has characterized the antibodies of the cited references as having "identical functional properties" to the claimed antibodies. The Examiner characterizes O'Brien and Yang as each teaching antibodies that bind to Cyr61. The Examiner alleges that based on extensive homology of Cyr61 across species, antibodies that bind human Cyr61 would likely bind Cyr61 homologs from other species. The Examiner required Applicant to demonstrate that the antibodies disclosed in the cited references do not have the same characteristics of the claimed antibodies. Applicant respectfully disagrees. Applicant respectfully asserts that the Examiner has failed to consider each and every element of the claim.

To anticipate a claim, the reference must teach each and every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987); MPEP 2131. Claim 65-77 cover antibodies that *specifically* bind to SEQ ID NO:4, which represents human Cyr61. While the antibodies described in O'Brien and Yang may bind to human Cyr61, they cannot bind *specifically* to human Cyr61 because they were raised to murine Cyr61. In view of the prior art antibodies not being *specific* to human Cyr61, Applicant respectfully requests that the Examiner withdraw the rejections under 35 U.S.C. § 102(b).

c. 35 U.S.C. § 103(a)

The Examiner has rejected claims 65 and 67-77 as obvious over O'Brien or Yang in view of Hoogenboom. The Examiner characterizes Hoogenboom as teaching methods of making chimeric or humanized antibodies. Due to the deficiencies of cited references O'Brien and Yang as discussed above, the additional citation of Hoogenboom fails to render the claimed antibodies obvious. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections under 35 U.S.C. § 103(a).

CONCLUSION

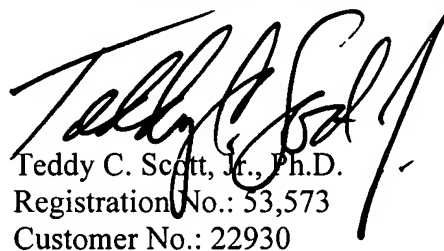
In view of the above amendments and remarks, Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

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By:


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